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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,182	08/02/2001	Gregory Maurice Plow	STL920000035US1	7553

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EXAMINER
MAMMEN, NATHAN SCOTT

ART UNIT	PAPER NUMBER
3671	

DATE MAILED: 12/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/922,182	PLOW ET AL.	
	Examiner	Art Unit	
	Nathan S Mammen	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11 and 13-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-11, 13-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 4, 6, 7, 8, 10, 11, 13, 14, 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Pub. No. 2002/0052925 to Kim et al.

The Kim '925 patent publication discloses a method of storing Internet advertisements at a user computer. The method comprises automatically receiving plural Internet advertisements (¶69), saving the plural advertisements at the user's computer (¶75), allowing a user to access the saved advertisements in an advertising history window (¶¶77-8), allowing a user to filter previously displayed advertisements (¶¶106-108), wherein the saved advertisement includes a link to a website (¶106), recalling the saved advertisement, and accessing the website.

Regarding claim 3, 4, 6, 10, 11, 13, 16, 17, 18, 19: The method further comprises displaying a button and displaying an advertisement in response to the button being toggled (¶110). The browser (Fig. 12) has a scroll function. The button is a previous and next button (i.e., "Back" and "Forward").

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 9, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2002/0052925 to Kim et al.

The Kim '925 patent publication discloses the claimed invention, as stated in paragraph 3 above, except for the advertisement including an HTML tag. The Kim '925 patent publication clearly states that the advertisements include URLs (¶106), and the publication further discloses that the advertisements may be in HTML format (¶77). Thus, in view of the disclosure of the Kim publication, it would be obvious to one having ordinary skill in the art to have provided the URLs in HTML format. Furthermore, it is notorious to those familiar with the Internet to use HTML for web-based software.

5. Claims 1-4, 6-11, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,099 to Barnett et al. in view of U.S. Patent 6,317,761 to Landsman et al., both cited in previous office actions.

The Barnett '099 patent discloses a method and system for storing and viewing Internet advertisements. Col. 8, lines 15-22. (While Barnett discloses the coupon packages file as comprising coupons and "other types of advertising materials," coupons themselves are advertisements.) The method and system comprise receiving a plurality of advertisements and saving the advertisements at the user computer. Col. 8, lines 29-34. The advertisements are received automatically. Col. 5, lines 35-46 (updating coupons automatically). The user can access the saved advertisements in an advertisement history window and can filter previously displayed advertisements so that only advertisement corresponding to selected attributes will be

displayed. Col. 9, lines 1-33; Fig. 2. The method and system further comprise displaying the advertisements in response to the user toggling a display button. Figs. 2 and 4B. The advertisements are available offline. Fig. 4B. What the Barnett '099 patent does not disclose is that the advertisements include HTML tags and that the advertisements are viewed in a browser window that can click on the tags to access a website. The Landsman '761 patent also discloses a method for storing and viewing Internet advertisements. Furthermore, the Landsman '761 patent teaches that it is known to automatically provide advertisements to a user without a user requesting them. The method comprises receiving plural Internet advertisements (col. 9, lines 56-58), with at least one Internet advertisement including a HTML tag (col. 9, line 64), and saving (col. 10, lines 12-24) the advertisements at the user computer at least partially based on the tag. The advertisements are viewed using browser software such as INTERNET EXPLORER or NETSCAPE (col. 16, lines 34-39); thus, the method and system of Landsman inherently comprises logic means for displaying the ads in response to toggled buttons, allowing the user to scroll through the advertisements, and displaying a "previous" and "next" button and accessing the advertisements in response to the toggling of these buttons since these are notoriously inherent functions of the aforementioned browser software. The saved advertisement also has a link to a website, and the website is accessed when the link on the advertisement is toggled (col. 17, lines 27-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the browser-based advertisement display system and method disclosed in Landsman into the downloadable advertisement method and system disclosed by Barnett, in order to provide the users of the Barnett advertisement system

with a familiar interface and an ability to access further advertisement information through the hyperlinked tags.

Response to Arguments

6. Applicants' arguments filed 10/22/04 have been fully considered but they are not persuasive.

As Applicants note, Kim is the published application of a non-provisional application filed *after* the filing date of the instant application; Kim claims priority to a provisional application filed *before* the filing date of the instant application. The examiner is quite aware of the requirements of MPEP §2136.03(III); in fact, the rejection of the claims based on the Kim publication is based on the examiner's belief that the relied-on sections of Kim are fully supported by the provisional application to which Kim claims priority. Contrary to Applicants' suggestion, the MPEP does not require the examiner to explain in detail how the provisional application supports the Kim publication. Also, current Office policy is that a provisional application providing the critical filing date for the non-provisional publication will not be mailed to an applicant against whom the non-provisional publication is applied, since the provisional application can be obtained by accessing USPTO's Public PAIR website at http://portal.uspto.gov/external/portal/pair.

Applicants argue that Kim also fails to show "an advertising history window displaying Internet content composed of plural advertisements." Claim 1, see Applicants' Remarks, page 2. Kim, Applicants say, displays only "**an** AD." Remarks, page 2 (emphasis Applicants').[1] Applicants appear to be arguing limitations that their own claims do not require and that their

[1] It should be noted that the sentence of Kim from which Applicant quotes starts with "for example."

specification certainly does not support. Claim 1 speaks of the advertising history window comprising a plurality of ads. Applicants' Fig. 3 is illustrative of this limitation. In this figure, it is quite obvious that the browser history window displays a plurality of ads in the menu portion (48). Though a plurality of ads can be displayed, only one ad is graphically displayed at a time- see "Ad History Window 50"; see also Specification, page 7, lines 11-12 ("[C]aptured ads can be presented to the user one at a time within an "Ad History" window 50...."). Nothing else in Applicants' specification suggests otherwise. Therefore, the claim 1, which states that the "advertising history window displaying Internet content composed of plural advertisements...," can only mean that the broader Ad History browser window (Applicants' Fig. 3) shows a menu consisting of plural advertisements (48) or that the Ad History Window (50) shows plural advertisements in succession. Kim discloses both. See Kim, ¶¶73, 75, 106-110.

Applicants' attempt to draw a distinction between "automatically downloading" advertisements, as instantly claimed, and "automatically deleting and updating", as disclosed in Barnett is without merit. Since the coupons are saved on a user's computer, it would be impossible to "automatically update" without also automatically downloading.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (703) 306-5959. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at (703) 308-3870. The fax number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-1113.

Thomas B. Will
Supervisory Patent Examiner
Group 3600

NSM
12/17/04

Nathan S. Mammen